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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91210367
Party	Defendant Arriva Medical, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ROCHE DIAGNOSTICS GMBH and ROCHE DIAGNOSTICS OPERATIONS, INC., Opposers, v. ARRIVA MEDICAL, LLC, Applicant.	))))))))))))	Opposition No. 91210367 Mark: ARRIVA MEDICAL Serial No.: 85-339,161

APPLICANT'S RESPONSE TO OPPOSER'S
MOTION TO STRIKE

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I. INTRODUCTION

Applicant Arriva Medical, LLC (hereinafter "Applicant") respectfully submits the following brief in response to the motion to strike by Roche Diagnostics GmbH and Roche Diagnostics Operations, Inc. (hereinafter "Opposers").

On June 3, 2013, Applicant filed its Answer to Notice of Opposition, Dkt. No. 4 ("Answer") in this matter, alleging certain affirmative defenses. On July 1, 2013, Opposers filed a combination Motion for Partial Summary Judgment and Motion to Strike, Dkt. No. 5 ("Motion") and their brief in support thereof ("Brief"). The headings relating to each defense specify that Opposers are moving for summary judgment on the defense of laches, and moving to strike the defenses of acquiescence, estoppel and waiver. The Board has already declined to consider the summary judgment portion of the Motion due to the fact that it was filed prematurely. Dkt. No. 6. The motion to strike is unpersuasive.

II. ARGUMENT

A. Estoppel and Waiver are Viable, Sufficiently Pled Affirmative Defenses.

Opposers make no supportable argument to strike Applicant's affirmative defenses of estoppel or waiver. Rather than arguing that waiver or estoppel are not applicable defenses in this matter, Opposers argue only that, because Applicant pled the same fact pattern for all four equitable defenses, estoppel and waiver either fail because laches and acquiescence do, or are factually unsupported. Even assuming, *arguendo*, that Opposers' arguments regarding Applicant's affirmative defenses of laches and acquiescence have some merit, Applicants pled estoppel and waiver with more than sufficient factual detail, and Opposers offer no persuasive authority to suggest that they should be stricken as duplicative.

1. Estoppel and Waiver are Pled with Considerable Factual Detail.

Opposers cite *Castro v. Cartwright*, Opposition No. 91188477, Dkt. No. 12 (TTAB Sept. 5, 2009), for the proposition that "an affirmative defense that fails to give an opposer or the Board any factual basis for the defense and is insufficient on its face must be stricken or dismissed." Brief, p. 10. *Castro* is indeed instructive, although not for the reasons suggested by Opposers.

The Board in *Castro* struck defenses of waiver and estoppel because that applicant had failed to do exactly what Applicant has done here. A "bald assertion of waiver is [not] sufficient." *Castro, supra*, at 6. The current case before the Board does not involve a "bald assertion." On the contrary, it involves a detailed fact pattern set forth in 2 1/2 pages. "As to … estoppel, it has been consistently held that the doctrine of estoppel may be invoked only by one who has been prejudiced by the conduct relied upon to create the estoppel…[In *Castro*,] applicant ha[d] not alleged that he was induced to select his mark because of the conduct of opposer." *Id.*, at 6-7. In this case, however, Opposers actively demanded that Applicant make use of the opposed mark ARRIVA MEDICAL, and Applicant pled as much in its Answer. Answer, Affirmative Defenses, ¶¶ 2(d), 2(f)-(i). Applicant further pled that it spent in excess of $12 million in advertising and marketing its ARRIVA MEDICAL goods and services during a period of more than two years, in express reliance upon Opposers' affirmative demand, which surely constitutes prejudicial reliance. *Id.* at ¶2(i).

The suggestion that the entire fact pattern as pled should be discounted, simply because some of those facts also apply to laches and acquiescence, is unsupported. The facts alleged for the four equitable defenses were presented as one coherent narrative, but not all of the facts necessarily apply to each defense, and there is no authority—cited by Opposers, or of which

Applicant is aware— for the proposition that any particular fact may be alleged only in support of a single claim or defense.

2. Estoppel and Waiver are Not Duplicative of Laches and Acquiescence.

No two equitable defenses consist of entirely duplicative elements; if they did they would not be recognized as distinct defenses. For instance, acquiescence requires an affirmative act, while laches can be based on silence and inaction. Estoppel requires that a party rely on the actions of another, while waiver can be found independent of such reliance. "A defendant may state as many separate defenses as it has, regardless of consistency; a defendant may also set forth two or more statements of a defense alternatively or hypothetically, either in one count or in two separate counts." TBMP § 311.02(b). There is clearly no rule against Applicant alleging multiple affirmative defenses that may overlap in elements or factual bases.

Opposers cite no precedent in which one affirmative defense was stricken as duplicative of another affirmative defense. They cite *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221 (TTAB 1995), for the proposition that affirmative defenses can be stricken as redundant, but, in that case, a defense was stricken because it merely restated a denial within the body of the answer, not because it was redundant to another affirmative defense. Opposers have not argued that estoppel and waiver are mere restatements of any denials in the Answer, and have therefore offered no valid reason to strike them as affirmative defenses.

B. Opposers' Arguments Fail to Meet the High Bar for a Motion to Strike Any of Applicant's Affirmative Defenses.

Even if an affirmative defense is duplicative of a denial or insufficient, "[m]otions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case." TBMP § 506.01; *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571

(TTAB 1988); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 USPQ 401, 402 (TTAB 1973). In *Order of Sons of Italy*, the Board declined to strike a second affirmative defense which, instead of restating, amplified a denial within the body of the Answer, because it "gave opposer more complete notice of the applicant's position." *Order of Sons of Italy*, *supra*, at 1223. *See also* TBMP § 506.01; *Harsco*, *supra*, at 1571, quoting 2A Moore's Federal Practice, Section 12.21[2] (2nd ed. 1985) ("Even if the allegations are redundant or immaterial, they need not be stricken if their presence in the pleading cannot prejudice the adverse party. If evidentiary facts are pleaded, and they aid in giving a full understanding of the complaint as a whole they need not be stricken.").

Applicant's pleaded equitable defenses provide detailed support for its substantive denial that there is a likelihood of confusion between the parties' respective marks, since the defenses state that Opposers affirmatively demanded that Applicant use the opposed mark, and took no action to prevent such use for more than two years thereafter. Thus, the defenses, and the facts pled in support of them, certainly cannot be said to have "no bearing upon the issues in the case." Striking the defenses would, therefore, be inappropriate even if the Board did find them "redundant or immaterial." Laches should also not be struck because Opposers only made it subject to the Motion for Summary Judgment, but all four defenses should survive under the high bar necessary to strike materials from a pleading.

III. CONCLUSION

The Board has already declined to consider the Summary Judgment portion of the Motion, which was the sole attack on the affirmative defense of laches, because it is untimely. Opposers have failed to offer any appropriate grounds for striking Applicant's affirmative

defenses of estoppel and waiver, and have offered inadequate arguments for striking the affirmative defense of acquiescence. Their motion to strike those defenses should be denied.

Respectfully submitted,

ARRIVA MEDICAL, LLC

July 19, 2013
Date

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Certificate of Service

I hereby certify that a true copy of this Response to Opposers' Motion to Strike was served upon Opposers' attorney of record, namely:

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